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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,103	09/17/2003	Justin Khoo	23831-08092	9339

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SUITE 410
PALO ALTO, CA 94306-2047

EXAMINER

MURRAY, DANIEL C

ART UNIT	PAPER NUMBER
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2143

MAIL DATE	DELIVERY MODE
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11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,103

Applicant(s)

KHOO ET AL.

Examiner

Daniel Murray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17SEP2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17SEP2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 26FEB2004
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements submitted on 17SEP2003, 28JAN2004, and 26FEB2004 have been considered by the Examiner and made of record in the application.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because:

- The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "10" and "12" have both been used to designate "network".
- The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "300" and "310" have both been used to designate "promotions folder".
- Examiner suggests renumbering the figures in a more straightforward manner for the sake of clarity.

Appropriate correction is required.

3. The numerous drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the drawings.

Specification

4. The disclosure is objected to because of the following informalities:
 - Paragraph [0041] line 2, replace "Is" before "an addition" with --is--

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- Paragraph [0044] line 1, replace “Is” before “the situation” with --is--
- Paragraph [0060] line 2, replace “a-mail” before “directly” with --e-mail--
- Paragraph [0069] line 2, replace “a-mail” before “directly” with --e-mail--

Appropriate correction is required.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1 and 3-5** are rejected under 35 U.S.C. 102(b) as being anticipated by **Lindberg (US Patent Publication # US 2002/0004825 A1)**.

a) Consider **claim 1**, Lindberg clearly shows and discloses, a method for placing preview enhanced messages in registration-based websites (abstract, paragraph [0002], paragraph [0009]), said method comprising; a user node having a browser program coupled to a network, said user node providing requests for information on said network (abstract, paragraph [0018], paragraph [0028], paragraph [0038], paragraph [0048]); and a promotions server node in operative association with a

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data repository responsive to a request and deliver promotions to said user node (abstract, paragraph [0014], paragraph [0015], paragraph [0038], paragraph [0039], paragraph [0048]).

b) Consider **claim 3**, Lindberg clearly shows and discloses, a method for sending and viewing preview enhanced messages, said method comprising (abstract, paragraph [0002], paragraph [0009]); sending a message from a message server to a recipient message client, said message including a portion that includes instructions for the delivery and viewing of preview content (abstract, paragraph [0015], paragraph [0016], paragraph [0028], paragraph [0038]); determining, at the recipient system, whether the said message contains the instructions for the delivery and viewing of said preview content (abstract, paragraph [0002], paragraph [0028]); when generating a summary listing of messages to show to the user, if the a message contains the said preview instructions, generating a trigger mechanism to allow the user to activate the preview associated with the message within the aggregate listing of messages (generating a summary listing of messages to show to the user is inherently from the teachings of Lindberg since in it well known that email readers (e.g. Outlook) and web browsers (e.g. Internet Explorer) list messages to show the user. Lindberg further teaches that opening the browser or email message using a trigger (e.g. mouse clicks) to view the preview)(abstract, paragraph [0002], paragraph [0004], paragraph [0004], paragraph [0018], paragraph [0019], paragraph [0036], paragraph [0036]); and upon the user triggering the preview, the preview content is retrieved from a preview server and displayed to the recipient on the display coupled to the client the user is using to retrieve and view the message (abstract, paragraph [0002], paragraph [0004], paragraph [0011], paragraph [0014], paragraph [0015], paragraph [0016], paragraph [0028], paragraph [0036], paragraph [0038], paragraph [0049]).

b) Consider **claim 4**, Lindberg clearly shows and discloses, a method for sending and viewing preview enhanced e-mail messages (abstract, paragraph [0002], paragraph [0009]), said

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method comprising; sending an E-mail message from an E-mail server to a recipient E-mail system over a public network (abstract, paragraph [0015], paragraph [0016], paragraph [0028], paragraph [0038]), said E-mail message including a portion that includes instructions for the delivery and viewing of e-mail preview content (abstract, paragraph [0015], paragraph [0016], paragraph [0028], paragraph [0038]); determining, at the E-mail recipient system, whether the said E-mail contains the instructions for the delivery and viewing of said preview content (abstract, paragraph [0002], paragraph [0028]); when generating a listing of e-mails to show to the user, if the an E-mail contains the said preview instructions, generating a visual cue and trigger mechanism to allow the User to activate the preview associated with the E-mail (generating a summary listing of messages to show to the user is inherently from the teachings of Lindberg since in it well known that email readers (e.g. Outlook) and web browsers (e.g. Internet Explorer) list messages to show the user. Lindberg further teaches that opening the browser or email message using a trigger (e.g. mouse clicks) to view the preview)(abstract, paragraph [0002], paragraph [0004], paragraph [0004], paragraph [0018], paragraph [0019], paragraph [0036], paragraph [0036]); and upon the user triggering the preview, the preview content is retrieved from a preview server and displayed to the recipient on a display coupled to the client the user is using to retrieve and view the e-mail (abstract, paragraph [0002], paragraph [0004], paragraph [0011], paragraph [0014], paragraph [0015], paragraph [0016], paragraph [0028], paragraph [0036], paragraph [0038], paragraph [0049]).

c) Consider **claim 5**, Lindberg clearly shows and discloses, a network comprising: a user node having a browser program coupled to said network, said user node providing requests for information on said network (abstract, paragraph [0018], paragraph [0028], paragraph [0038], paragraph [0048]); a central data repository having memory in which is stored incentive offer data and remote user data (abstract, paragraph [0002], paragraph [0014], paragraph [0015], paragraph

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[0038], paragraph [0039], paragraph [0048]); a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide content and promotions space for display of targeted promotions to said user node (abstract, paragraph [0002], paragraph [0014], paragraph [0016], paragraph [0038], paragraph [0039], paragraph [0053]); a promotions client node responsible for pulling promotions content from an promotions server node in response to a user request from said user node to display (abstract, paragraph [0013], paragraph [0038], paragraph [0039]); and a promotions server node in operative association with the central data repository responsive to a request from said promotions client node and deliver promotions to said promotions client, whereby said promotions content from said selected advertiser node is displayed at said user node (abstract, paragraph [0014], paragraph [0015], paragraph [0038], paragraph [0039], paragraph [0048]).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lindberg (US Patent Publication # US 2002/0004825 A1)** in view of **Griffin et al. (US Patent # 5,307,086)**.

a) Consider **claim 2**, Lindberg clearly shows and discloses, a method for viewing and browsing a listing of e-mail messages (abstract, paragraph [0002], paragraph [0004]), said method comprising; generating a listing of e-mail messages within an e-mail data store (inherent from the teachings of Lindberg since email readers (such as Outlook) providing a listing of emails which is generated from an email data store)(abstract, paragraph [0002], paragraph [0004]); and showing a summary of the e-mail content (paragraph [0002], paragraph [0009]). However, Lindberg does not specifically disclose providing a trigger mechanism for each e-mail message in the listing, said trigger capable of opening up a window when triggered by the user.

Griffin et al. show and disclose a method of implementing a preview window in and object oriented programming system, whereby a user may view underlying information in an application. Griffin et al. disclose providing a trigger mechanism (figure 3, column 2 lines 12-23, column 4 lines 24-36) for each e-mail message in the listing, said trigger capable of opening up a window when

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triggered by the user (figure 3, abstract, column 1 lines 61-67, column 2 lines 1-23, column 4 lines 24-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Griffin et al. into the system of Lindberg for the purpose of allowing the user to preview the contents without having to open the email (column 1 lines 20-30, column 2 lines 31-35).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Baker (US Patent # US 6,546,417 B1) discloses: "Enhanced Electronic Mail System Including Methods and Apparatus for Identifying MIME Types and for Displaying Different Icons"
- Nielsen (US Patent # 5,937,417) discloses: "Tooltips on Webpages"
- Henrick et al. (US Patent # US 6,377,936 B1) disclose: "Method for Performing Targeted Marketing Over a Large Computer Network"
- Gough et al. (US Patent # US 6,360,221 B1) disclose: "Method and Apparatus for the Production, Delivery, and Receipt of Enhanced E-Mail"
- Venkatraman et al. (US Patent # 6,014,688) disclose: "E-Mail Program Capable of Transmitting, Opening, and Presenting a Container Having Digital Content Using Embedded Executable Software"
- Langheinrich et al. (US Patent # US 6,654,725 B1) disclose: "System and Method for Providing Customized Advertising on the World Wide Web"
- Sgaraglino (US Patent Pub # US 2003/0229893 A1) discloses: "Multiple Responsive Means for Interactive Advertising and Information Systems"

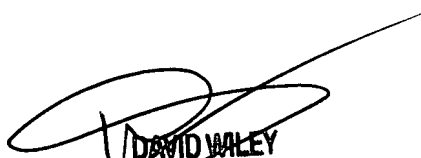
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Murray whose telephone number is (571)-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DCM



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